

### REMARKS

Reconsideration of the Office Action mailed December 24, 2002, (hereinafter "instant Office Action"), entry of the foregoing amendments and withdrawal of the rejection of claims 16-26, are respectfully requested.

In the instant Office Action, claims 16-26, 37 and 38 are listed as pending, claims 16-26 are listed as rejected and claims 37 and 38 are listed as allowed.

Attached hereto as Appendix A is a marked-up version of the changes made to the claims by the current amendments. Appendix A is captioned "**Version with markings to show changes made**".

The Examiner acknowledges that a request for continued examination under 37 CFR §1.114, including the fee set forth in 37 CFR §1.17(e) was filed in this application after final rejection. Applicants gratefully acknowledge that the finality of the previous Office action has been withdrawn pursuant to 37 CFR §1.114 and that applicants' submission filed on September 27, 2002 has been entered.

In the instant Office Action the Examiner has not mentioned the rejection under 35 U.S.C. §112, second paragraph, claims 16-26 with respect to the term "heteroaryl", claim 16 with respect to the term R<sup>2</sup>; and claims 20 and 21 with respect to the term "tetrahydrofuran". Therefore, Applicants presume that the arguments and amendments submitted in the Preliminary Amendment filed concurrently with the Continued Prosecution Application Request filed on September 17, 2002 was persuasive and the rejections have been withdrawn. Applicants respectfully request that the Examiner affirmatively state this in the next official communication.

The Examiner has rejected claims 16-26 under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants respectfully traverse this rejection. Applicants maintain the arguments presented in the Reply mailed November 26, 2001 and the Preliminary Amendment filed concurrently with the Continued Prosecution Application Request filed on September 27, 2002.

In the instant Office Action the Examiner states that in *In re Johnson*, 194 USPQ 187, the fact situation was different than in *In re Grasselli*, because in *In re Johnson* the claims were

narrowed to avoid material lost in an interference, and thus *In re Johnson* will not be followed. Applicants respectfully disagree with the Examiner and maintain that *In re Johnson* is applicable to the instant application. Although in *In re Johnson* the claims were narrowed to avoid material lost in an interference, the question at issue was whether the written description enabled the claims, not what motivated the Applicants to insert the proviso. This is the same question as in the instant application. Whether a proviso is added to a claim in response to a lost count in an interference or to overcome a 102(b) reference is irrelevant. What is common is that the claim was amended to remove subject matter that the priority filing did not provide support for. As was stated in *In re Wertheim*, 541 F.2d, 257, 263, 191 USPQ 90, 97 (CCPA 1976):

Inventions are constantly made which turn out not to be patentable, and applicants frequently discover during the course of prosecution that only a part of what they invented and originally claimed is patentable.

As acknowledged in *In re Saunders*, 58 CCPA 1316, 1327, 444 F.2d 599, 607, 170 USPQ 213, 200 (1971), it is for the inventor to decide what bounds of protection he will seek.

Adequate description under the first paragraph of 35 U.S.C. 112 does not require literal support for the claimed invention. *In re Herschler*, 591 F.2d 693, 200 USPQ [\*5] 711 (CCPA 1979); *In re Edwards*, 568 F.2d 1349, 196 USPQ 465 (CCPA 1978); *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). Rather, it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that an applicant had possession of the concept of what is claimed. *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973).

Applicants' written description clearly conveys that Applicants had possession of the instant invention at the time of filing. One of ordinary skill in the art of medical chemistry would understand the written description and claims as filed by Applicants, as well as the amended claims. The application as originally filed provided adequate written description for the claims as originally filed. The proviso inserted by Applicants merely excises a small group of compounds. It does not change the nature of the instant invention. Since a narrower breadth is encompassed by the amended claim, and the application as originally filed provided adequate written description for the originally-filed claims, it follows that a claim of narrower scope is necessarily supported. Therefore, the instant specification still provides the requisite description for claims 16-26.

Based upon the foregoing, the rejection of claims 16-26 under 35 U.S.C. §112, first paragraph, is obviated and should be withdrawn.

The Examiner has rejected claims 16-26 under 35 U.S.C. §112, second paragraph, for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner alleges that claim 16 is indefinite in that the metes and bounds of "a substituent" are unknown and that there is no definition for this term in the specification. The Examiner acknowledges that there is, however, a definition of "suitable substituent" in the specification. The Examiner further alleges that the term "substituted or unsubstituted" throughout claims 16-22 is unclear as to the nature and number of substituent(s) intended. Applicants respectfully traverse this rejection.

The 3rd Circuit Court has stated the following on the issue of knowledge of one skilled in the art and its relationship to the extent of disclosure required in a specification:

It is axiomatic that no description, however detailed, is 'complete' in a rigorous sense. Every description will rely to some extent on the reader's knowledge of the terms, concepts, and depictions it embodies. Thus, an understanding of any description will involve some measure of inference....[S]kill in the art can be relied upon to supplement that which is disclosed as well as to interpret what is written.

Rengo Co. Ltd. v. Molins Mach. Co., 657 F.2d 535, 211 USPQ 203 (3d Cir. 1980), *cert. denied*, 454 U.S. 1055.

Furthermore, Applicants list suitable substituents on page 11, line 23 to page 12, line 22. Substituents for R in preferred compounds are listed on page 18, line 15 to page 19, line 29. In addition, Applicants provide assays for testing compounds to determine whether they inhibit protein kinase activity and Applicants have provided 338 examples in the instant specification which illustrate numerous substituents, although Applicants have no duty to provide working examples.

One of ordinary skill in the art would know what substituents would be suitable, as the nature and number of substituent(s) would be limited by the structure of the compound and the availability of binding sites. Applicant maintains that one skilled in the art is familiar with the above-noted terms and that the specification is fully enabling with respect to the terms objected to by the Examiner. Notwithstanding the foregoing, without conceding to the correctness of the

Examiner's rejections and for the sole purpose of expediting prosecution of the instant application and to place it in condition for allowance, Applicants have amended claim 16 to include the phrase "suitable substituents". Accordingly, the rejection of claims 16-26 under 35 U.S.C. §112, second paragraph, for the foregoing reason is obviated and should be withdrawn.

No fees are due for the instant amendment since the total number of claims after entry of the amendment hereinabove is not more than the total number of claims that Applicants have paid for to date.

Based upon the foregoing, Applicants believe that claims 16-26 are in condition for allowance. Prompt and favorable action is earnestly solicited.

If the Examiner believes that a telephone conference would advance the condition of the instant application for allowance, Applicants invite the Examiner to call Applicants' agent at the number noted below.

Respectfully submitted,

Date: March 27, 2003



**Gayle B. O'Brien**  
Agent for Applicants  
Reg. No. 48,812

Abbott Bioresearch Center  
100 Research Drive  
Worcester, MA 01605  
(508) 688-8053

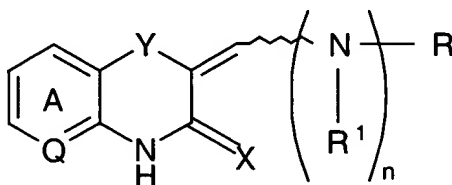


APPENDIX A

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the claims:

17. A compound represented by the following structural formula:



or physiologically acceptable salts thereof, wherein:

ring A is substituted with suitable substituents or unsubstituted;

Q is  $-N=$  or  $-CR^2=$ ;

X is S, O or  $NOR^3$ ;

Y is  $-S-$ ,  $-SO-$  or  $-SO_2-$

$R^2$  is  $-H$  or a substituent;

$R^3$  is  $-H$  or  $-C(O)R^4$ ;

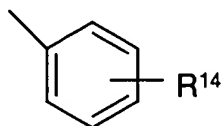
$R^4$  is a substituted with suitable substituents or unsubstituted aliphatic or aromatic group;

n is 0 or 1; and wherein

when X is S or  $NOR^3$ , R is an optionally substituted with suitable substituents aromatic or aralkyl group and  $R^1$  is hydrogen or a substituted with suitable substituents or unsubstituted aliphatic group;

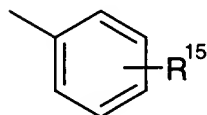
when X is O and n is 0,  $R^1$  is hydrogen or a substituted with suitable substituents or unsubstituted aliphatic group and R is a substituted with suitable substituents or unsubstituted aromatic or aralkyl group, provided that R is not 2-thienyl, benzoxadiazolyl, 4-oxo-4H-1-benzopyran-3-yl, 6-chloro-4-oxo-4H-1-benzopyran-3-yl, 6-methyl-4-oxo-4H-1-benzopyran-3-yl, 6-acetyloxy-4-oxo-4H-1-benzopyran-3-yl, naphthyl, 3-furanyl, 2-furanyl, 2-yrityl, 3-pyridinyl, 4-pyridyl, 2,4-dichlorophenyl, 2,6-

dichlorophenyl, 4-acetyloxy-3-methoxyphenyl, 3,5-dimethoxyphenyl, 3,4,5-trimethoxyphenyl, 3,5-*t*-butyl-4-hydroxyphenyl, 3,5-*i*-propyl-4-hydroxyphenyl, 3-(2-hydroxyphenyl)-1H-pyrazol-4-yl, 3-(5-chloro-2-hydroxyphenyl)-1H-pyrazol-4-yl, or



where R<sup>14</sup> is H, *p*-F, *o*-Cl, *p*-Cl, *p*-Br, *m*-Br, *o*-CH<sub>3</sub>, *p*-CH<sub>3</sub>, *p*-OCH<sub>2</sub>CH<sub>3</sub>, -O-Benzyl, CF<sub>3</sub>, phenyl, -OCH<sub>3</sub>, -O-phenyl, NO<sub>2</sub>, -OC(O)CH<sub>3</sub>, OCH<sub>2</sub>C(O)C<sub>2</sub>H<sub>5</sub>, -OCH<sub>2</sub>C(O)NHNH<sub>2</sub>, *p*-(-O-(CH<sub>2</sub>)<sub>5</sub>-N(CH<sub>3</sub>)<sub>2</sub>), *p*-(-O-(CH<sub>2</sub>)<sub>3</sub>-N(n-C<sub>3</sub>H<sub>7</sub>)<sub>2</sub>), *p*-(3-piperidin-1-yl-propan-1-oxy), *m*-(2-morpholin-4-yl-ethan-1-oxy), or *m*-(4-(4-ethyl-piperazin-1-yl)-butan-1-oxy); and

when X is O and n is 1, R<sup>1</sup> is H or a substituted with suitable substituents or unsubstituted aliphatic group and R is a substituted with suitable substituents or unsubstituted aromatic or aralkyl group, provided that R is no 4-nitro-2-methoxyphenyl, 4-methoxy-2-nitrophenyl, 4-chloro-2-nitrophenyl, 2,5-dichlorophenyl, or



where R<sup>15</sup> is H, Cl, *p*-NO<sub>2</sub>, *o*-NO<sub>2</sub>, *p*-OCH<sub>3</sub>, *o*-CO<sub>2</sub>H, CH<sub>3</sub> or CF<sub>3</sub>.